REMARKS

Claims 1, 3, 5-6, 8-9, 11, 13-14, 16-17, 19, 21-22, and 24 are all the claims pending in the application. Claims 7, 15, and 23 are herein canceled without prejudice or disclaimer. Claims 2, 4, 10, 12, 18, and 20 have been previously canceled without prejudice or disclaimer. Claims 1, 5, 9, 13, 17, and 21 are amended herein. No new matter is being added. Claims 1, 3, 5-9, 11, 13-17, 19 and 21-24 stand rejected on prior art grounds. Applicants respectfully traverse these rejections based on the following discussion.

I. The Prior Art Rejections

Claims 1, 3, 6-9, 11, 14-17, 19 and 22-24 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Miller, et al. (U.S. Patent No. 5,640,569), hereinafter referred to as "Miller", in view of Krishnaswamy, et al. (U.S. Patent No. 5,867,494), hereinafter referred to as "Krishnaswamy", in view of Gray, et al. (U.S. Publication No. 2002/0082856 A1), hereinafter referred to as "Gray", and in further view of Ferstenberg, et al. (U.S. Patent No. 5,873,071), hereinafter referred to as "Ferstenberg". Claims 5, 13 and 21 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Miller and Krishnaswamy, in view of Ferstenberg. Applicants respectfully traverse these rejections based on the following discussion.

Amended independent claims 1, 9 and 17 contain features not rendered obvious by the combined prior art references of record. Particularly, independent claims 1, 9, and 17 generally include the additional features, "enabling the customers to provide price and service level related inputs to their respective software-based agents; and enabling said software-based agents representing customers to monitor the usage of resources allocated to them and the levels of service being obtained,...wherein each class of resources has some units dedicated to specific

customers with remaining units being dynamically allocated to customers by the resource center." By incorporating such a feature in the independent claims, all four prior art references of record, namely, Miller, Krishnaswamy, Gray, and Ferstenberg, as well as the precepts taken as Official Notice, would have to be combined in various combinations with one another in order to try and teach, but failing nonetheless, the amended claimed language.

More particularly, Official Notice is taken on page 6 of the Office Action. As such, Applicants respectfully make a demand for evidence supporting the position taken in the Office Action, and in particular in the Official Notice, that it is old and well known in the goods and services industry that each class of resources has some units has some units dedicated to specific customers with remaining units being dynamically allocated to customers by the resource center." First, a demand is made for evidence indicating whether such a teaching is in fact old and well known, and second a demand is make for evidence teaching this concept within the framework of a web server farm and a dynamic negotiation, as provided by the amended independent claims.

Next, even assuming that the references would have been combined, Miller does not teach or suggest the features of independent claim 1, and similarly independent claims 9 and 17, including "dynamically allocating and pricing resources is accomplished through mutual on-line negotiations between the customers and the resource center through electronic communications, and the mutual online negotiations takes place between software-based agents representing the customers and the resource center,... enabling the customers to provide price and service level related inputs to their respective software-based agents; and enabling said software-based agents representing customers to monitor the usage of resources allocated to them and the levels of service being obtained,... wherein each class of resources has some units dedicated to specific

customers with remaining units being dynamically allocated to customers by the resource center." (See Page 5, lines 5-7; Page 6, lines 1-2; Page 9, lines 10-15; Page 10, lines 9-10; and Page 14, line 19-Page 15, line 5).

Applicant agrees with the Examiner that Miller "does not specifically disclose dynamic allocation of resources," accordingly Miller is deficient in not disclosing or teaching Applicant's claimed invention. (See Office Action, Page 5, lines 4-7).

Krishnaswamy is also deficient.

Indeed, contrary to the assertion in the Office Action, there is no teaching or suggestion in Krishnaswamy regarding negotiating the allocation and pricing of resources based on any one of several parameters, let alone, that dynamically allocating and pricing resources is accomplished through mutual negotiations. Rather, Krishnaswamy merely states in column 31, lines 48-51 that the allocation techniques range from a "static configuration to [a] fully dynamic allocation of resources on a transaction by transaction basis."

Accordingly, there is no teaching of implementing a negotiation technique whereby any one of the following parameters are used: "the customers requesting the resource center to acquire and release resources at any time; the resource center conducting an auction of all available resources in a shared resource pool at predetermined intervals to determine the allocation and pricing of the resources for a subsequent time interval; and the resource center publishing said prices at which the resources of the shared resource pool can be acquired or released by the customers, whereby the customers use the prices for determining whether to request releasing or acquiring said resources." These differences distinguish the claimed invention from the prior art references, but also indicate that the prior art references each take mutually exclusive paths to solve wholly unique and different problems. In this regard, the prior

art references actually teach away from the claimed invention due to the different solutions and different problems which are the subject of the respective prior art references. Therefore, Krishnaswamy, like Miller, does not disclose, teach or suggest including "dynamically allocating and pricing resources is accomplished through mutual on-line negotiations between the customers and the resource center through electronic communications, and the mutual online negotiations takes place between software-based agents representing the customers and the resource center,... enabling the customers to provide price and service level related inputs to their respective software-based agents; and enabling said software-based agents representing customers to monitor the usage of resources allocated to them and the levels of service being obtained,... wherein each class of resources has some units dedicated to specific customers with remaining units being dynamically allocated to customers by the resource center." (See above).

For emphasis, Applicant further agrees with the Examiner that Miller and Krishnaswamy do not specifically disclose "allocating of the resources includes transferring, by the resource center, the resources from one customer to another customer." Applicant also agrees with the Examiner that Miller and Krishnaswamy do not specifically disclose that "mutual online negotiations can take place between software-based agents representing the customers and the resource center." (See Office Action, Page 5, lines 17-20; and Page 7, Section 8, lines 5-10).

Gray is also deficient.

Indeed, Gray merely discloses a resource sharing system using sliding constraints for dynamically adjusting the priorities at which requests from applications in different request classes for a shared resource are processed. Contrary to the assertion in the Office Action, Gray only discloses that "resources are allocated by entities on the basis of negotiated guarantees of availability," not dynamically allocating and pricing resources is accomplished through mutual

negotiations between the customers and the resource center through electronic communications or otherwise, let alone. the mutual online negotiations takes place between software-based agents representing the customers and the resource center.

The Office Action clearly indicates that Gray does not teach the above features as only the Ferstenberg reference is cited as potentially teaching that the mutual online negotiations takes place between software-based agents representing the customers and the resource center, for example, claims 4, 12 and 20. Therefore, Gray also does not disclose, teach or suggest including "dynamically allocating and pricing resources is accomplished through mutual on-line negotiations between the customers and the resource center through electronic communications, and the mutual online negotiations takes place between software-based agents representing the customers and the resource center,... enabling the customers to provide price and service level related inputs to their respective software-based agents; and enabling said software-based agents representing customers to monitor the usage of resources allocated to them and the levels of service being obtained,... wherein each class of resources has some units dedicated to specific customers with remaining units being dynamically allocated to customers by the resource center." (See Gray at Abstract; and Page 3, Paragraph [0036]).

Second, even assuming that the references would have been combined, Miller, as discussed above, does not teach or suggest the features of independent claim 1, and similarly independent claims 9 and 17, which incorporate dependent claims 2, 4, 10, 12, 18, and 20, including "dynamically allocating and pricing resources is accomplished through mutual on-line negotiations between the customers and the resource center through electronic communications, and the mutual online negotiations takes place between software-based agents representing the customers and the resource center,... enabling the customers to provide price and service level

related inputs to their respective software-based agents; and enabling said software-based agents representing customers to monitor the usage of resources allocated to them and the levels of service being obtained,... wherein each class of resources has some units dedicated to specific customers with remaining units being dynamically allocated to customers by the resource center." (See Page 5, lines 5-7; Page 6, lines 1-2; Page 9, lines 10-15; Page 10, lines 9-10; and Page 14, line 19-Page 15, line 5).

Ferstenberg is also deficient.

Indeed, Ferstenberg merely discloses software processes distributed on one or more computer systems that exchange messages in order to facilitate an intermediated exchange of financial commodities between a plurality of participants. The messages are exchanged according to a preferred protocol that leads to a satisfactory exchange that meets the objectives of the participants, and that substantially maximizes in a fair manner the total amount of financial commodities exchanged.

Applicant respectfully submits that the Office Action mischaracterizes Ferstenberg as Ferstenberg only teaches that "it permits the flexibility to dynamically adapt to market conditions that affect the price and availability of individual commodities," not dynamically allocating and pricing resources is accomplished through mutual on-line negotiations between the customers and the resource center through electronic communications or otherwise, as claimed by Applicant. (See Ferstenberg at Abstract; and Column 2, lines 36-47).

Further, Ferstenberg includes a preferred message-exchange protocol for the construction of computer programs representing exchange participants and an intermediary. These constructed computer programs exchange messages such that a satisfactory intermediated exchange of commodities is substantially certain to be achieved. This approach is different and

wholly unique from the claimed invention, which is not specifically directed to message-exchange protocols.

Accordingly, contrary to the assertion in the Office Action, Ferstenberg only discloses that "electronic agents (e-agents), each of which represents a participant's exchange goals, and electronic intermediary, through which the e-agents conduct electronic negotiations lead to an intermediated exchange." Consequently, Ferstenberg teaches a passive, message exchange through a single electronic intermediary, whereas, Applicant discloses that active mutual online negotiations takes place between software-based agents representing the customers and the resource.

Therefore, Ferstenberg like Krishnaswamy and Miller, does not disclose, teach or suggest including "dynamically allocating and pricing resources is accomplished through mutual on-line negotiations between the customers and the resource center through electronic communications, and the mutual online negotiations takes place between software-based agents representing the customers and the resource center,... enabling the customers to provide price and service level related inputs to their respective software-based agents; and enabling said software-based agents representing customers to monitor the usage of resources allocated to them and the levels of service being obtained,... wherein each class of resources has some units dedicated to specific customers with remaining units being dynamically allocated to customers by the resource center." (See Column 3, lines 22-41).

For at least the reasons outlined above, Applicant respectfully submits that none of Miller, Krishnaswamy, Gray, Ferstenberg, or the concepts taken as Official Notice, alone or in combination, disclose, teach or suggest, including as recited in independent claim 1, and similarly independent claims 9 and 17, of Applicant's invention, including "enabling the

customers to provide price and service level related inputs to their respective software-based agents; and enabling said software-based agents representing customers to monitor the usage of resources allocated to them and the levels of service being obtained,... wherein each class of resources has some units dedicated to specific customers with remaining units being dynamically allocated to customers by the resource center."

Indeed, Applicant submits that at least four separate and distinct references as well as concepts identified as Official Notice have been arbitrarily "lumped" together in an attempt to disclose Applicant's invention. Insofar as references may be combined to teach a particular invention, and the proposed combination of Miller, Krishnaswamy, Gray, Ferstenberg, and concepts identified as Official Notice, in various combinations with one another, case law establishes that, before any prior-art references may be validly combined for use in a prior-art 35 U.S.C. § 103(a) rejection, the individual references themselves or corresponding prior art must suggest that they be combined.

For example, in In re Sernaker, 217 U.S.P.Q. 1, 6 (C.A.F.C. 1983), the court stated: "[P]rior art references in combination do not make an invention obvious unless something in the prior art references would suggest the advantage to be derived from combining their teachings." Furthermore, the court in Uniroyal, Inc. v. Rudkin-Wiley Corp., 5 U.S.P.Q.2d 1434 (C.A.F.C. 1988), stated, "[w]here prior-art references require selective combination by the court to render obvious a subsequent invention, there must be some reason for the combination other than the hindsight gleaned from the invention itself. . . . Something in the prior art must suggest the desirability and thus the obviousness of making the combination."

In the present application, the reason given to support the proposed combination is improper, and is not sufficient to selectively and gratuitously substitute parts of one reference for

a part of another reference in order to try to meet, but failing nonetheless, the Applicant's novel claimed invention. Furthermore, the claimed invention, as amended, meets the above-cited tests for obviousness by including embodiments such as "...enabling the customers to provide price and service level related inputs to their respective software-based agents; and enabling said software-based agents representing customers to monitor the usage of resources allocated to them and the levels of service being obtained,...wherein each class of resources has some units dedicated to specific customers with remaining units being dynamically allocated to customers by the resource center." as generally recited in amended claims 1, 9, and 17. As such, all of the claims of this application are, therefore, clearly in condition for allowance, and it is respectfully requested that the Examiner pass these claims to allowance and issue.

As declared by the Federal Circuit:

> In proceedings before the U.S. Patent and Trademark Office, the Examiner bears the burden of establishing a prima facie case of obviousness based upon the prior art. The Examiner can satisfy this burden only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references. In re Fritch, 23 U.S.P.Q.2d 1780, 1783 (Fed. Cir. 1992) citing In re Fine, 5 U.S.P.Q.2d 1596, 1598 (Fed. Cir. 1988).

Here, the Examiner has not met the burden of establishing a prima facie case of obviousness. It is clear that, not only does Miller fail to disclose all of the elements of the claims of the present invention, particularly, the dynamic allocation of resources and the manner of customer and resource center negotiations, as discussed above, but also, if combined with Krishnaswamy, Gray, Ferstenberg, and concepts identified as Official Notice fails to disclose these elements as well. The unique elements of the claimed invention are clearly an advance over the prior art.

The Federal Circuit also went on to state:

> The mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification. . . . Here the Examiner relied upon hindsight to arrive at the determination of obviousness. It is impermissible to use the claimed invention as an instruction manual or "template" to piece together the teachings of the prior art so that the claimed invention is rendered obvious. This court has previously stated that one cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention. Fritch at 1784-85, citing In re Gordon, 221 U.S.P.Q. 1125, 1127 (Fed. Cir. 1984).

Here, there is no suggestion that Miller, alone or in combination Krishnaswamy, Gray, Ferstenberg, and/or concepts identified as Official Notice teaches a structure and method containing all of the limitations of the claimed invention. Consequently, there is absent the "suggestion" or "objective teaching" that would have to be made before there could be established the legally requisite "prima facie case of obviousness."

In view of the foregoing, the Applicant respectfully submits that the collective cited prior art do not teach or suggest the features defined by amended independent claims 1, 9, and 17 and as such, claims 1, 9, and 17 are patentable over Miller alone or in combination with Krishnaswamy, Gray, Ferstenberg, and/or concepts identified as Official Notice. Further, dependent claims 3, 5-6, 8, 11, 13-14, 16, 19, 21-22, and 24 are similarly patentable over Miller alone or in combination with either Krishnaswamy, Gray, Ferstenberg, and/or concepts identified as Official Notice, not only by virtue of their dependency from patentable independent claims, respectively, but also by virtue of the additional features of the invention they define. Thus, the Applicant respectfully requests that these rejections be reconsidered and withdrawn.

Moreover, the Applicant notes that all claims are properly supported in the specification and accompanying drawings, and no new matter is being added. In view of the foregoing, the Examiner is respectfully requested to reconsider and withdraw the rejections.

II. Formal Matters and Conclusion

With respect to the rejections to the claims, the claims have been amended, above, to overcome these rejections. In view of the foregoing, the Examiner is respectfully requested to reconsider and withdraw the rejections to the claims.

In view of the foregoing, Applicants submit that claims 1, 3, 5-6, 8-9, 11, 13-14, 16-17, 19, 21-22, and 24, all the claims presently pending in the application, are patentably distinct from the prior art of record and are in condition for allowance. The Examiner is respectfully requested to pass the above application to issue at the earliest possible time.

Should the Examiner find the application to be other than in condition for allowance, the Examiner is requested to contact the undersigned at the local telephone number listed below to discuss any other changes deemed necessary. Please charge any deficiencies and credit any overpayments to Attorney's Deposit Account Number 09-0441.

Respectfully submitted,

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